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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,593	12/31/2003	Albrecht Marhold	Mo 5346D2/LcA 32 314D2	8545

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EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/749,593

Applicant(s)

MARHOLD ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-7, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 is/are allowed.
- 6) ☒ Claim(s) 4-7, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant's arguments with respect to claims 3-7 and 12-13 have been considered but are moot in view of the new ground(s) of rejection.

The Status of Claims

Claims 3-7 and 12-13 are pending.

Claims 4-7, 12, and 13 have been rejected.

Claim 3 is allowable.

**DETAILED ACTION**

**Specification**

The disclosure is objected to because of the following informalities:.

Concerning the priority data, the application( # 10/227,310) (08/26/02) abandoned on 7/27/2004 provided by applicants is inconsistent with PTO record.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the continuing data are not present.

In the application data sheet (37 C.F.R. 1.76), the title of Invention is recited as below:

Art Unit: 1625

**3-Cyano-2,4,5-Trifluorobenoxyl Fluoride and Intermediate Products for the Production Thereof**

The part of the chemical term "benoxyl" in the title is mis-spelled. Therefore, an appropriate correction is required.

The application( # 10/227,310) (08/26/02) abandoned on 7/27/2004 provided by applicants is inconsistent with PTO record. Therefore, an appropriate correction is required.

***Claim Rejections - 35 USC § 112***

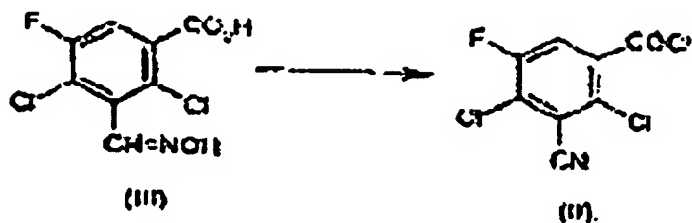
The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-7, 12, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

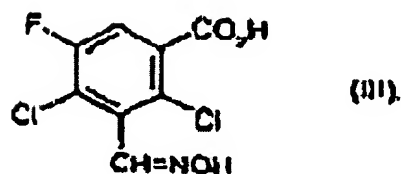
In claim 4 , the chemical formulas (II) and (III) are shown below:

Art Unit: 1625



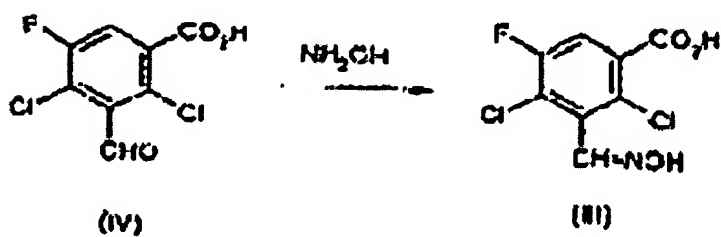
. The chemical formulas (II) and (III) are vague and indefinite because some of the substituents on the benzene ring are unrecognizable. Therefore, an appropriate correction is required.

In claim 5 , the chemical formula (III) is shown below:



The chemical formula (III) is vague and indefinite because some of the substituents on the benzene ring are unrecognizable. Therefore, an appropriate correction is required.

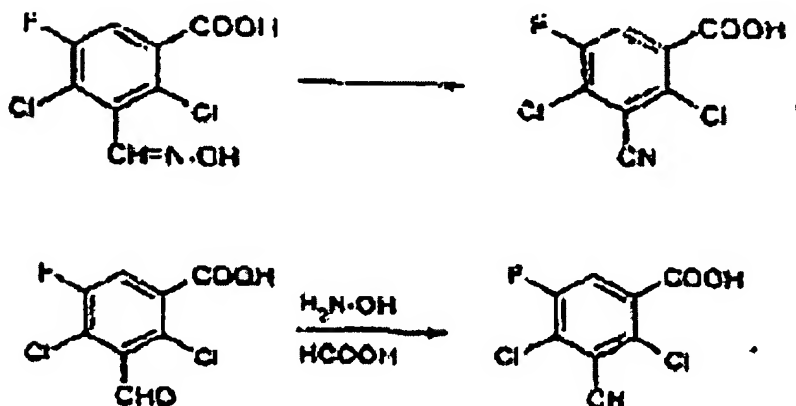
In claim 6 , the chemical formulas (III) and (IV) are shown below:



Art Unit: 1625

The chemical formulas (III) and (IV) are vague and indefinite because some of the substituents on the benzene ring are unrecognizable. Therefore, an appropriate correction is required.

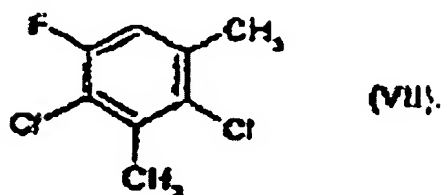
In claim 7 , the chemical formulas are shown below:



The chemical formulas are vague and indefinite because some of the substituents on the benzene ring are unrecognizable. Therefore, an appropriate correction is required.

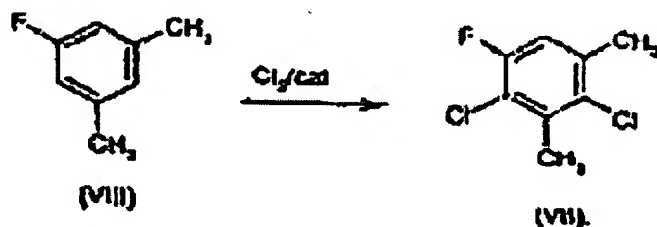
In claim 12 , the chemical formula is shown below:

Art Unit: 1625



The chemical formula (VII) is vague and indefinite because some of the substituents on the benzene ring are unrecognizable. Therefore, an appropriate correction is required.

In claim 13 , the chemical formulas (VIII) and(VII) are shown below:



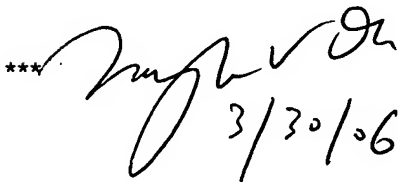
The chemical formulas (VIII) and(VII) are vague and indefinite because some of the substituents on the benzene ring and terms are unrecognizable. Therefore, an appropriate correction is required.

Art Unit: 1625

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/30/06